

P&G Case 8163

09/902,048

Upon entry of the amendments presented, Claims 1-12 are pending in the application. Claim 1 has been amended to remove the term "preferably" and modify the upper limit on the water amount from 95% to 90%. Support for these amendments may be found in the claims as originally filed. Claim 7 has been amended to remove the superfluous phrase "further comprising". Claim 10 has been amended to clarify that the claimed elastomer may be a physical mixture of a non-emulsifying and emulsify elastomer. Support for this amendment can be found at page 8, lines 4 and 5. Claim 11 has been amended to remove the phrases "vitamins and derivatives thereof" and "agents suitable for aesthetic purposes". No new matter has been added.

Invention Synopsis

The invention relates to a method for removing transfer resistant make-up compositions comprising the step of applying a safe and effective amount of a make-up removing composition comprising: (i) from about 0.1 to about 30% of a crosslinked siloxane elastomer, said elastomer having a particle size of from above 10 to about 200 microns; (ii) from about 10 to about 80% of a solvent having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2}; and (iii) optionally, from about 0% to about 90% water. Applicants have found that the claimed methods provide improved removal of transfer resistant makeups.

Formal Matters

The Office asserts that the incorporation of essential material into the specification by reference to a foreign application or patent, or to a publication is improper. In particular, the Office questions the description of solubility parameters and means for determining them that is mentioned at page 9, lines 6-10 of the specification. Applicants assert that the objection has been obviated by Applicants' amendment of the specification to remove the "incorporation by reference" statement relative to the solubility parameter article that appears in the section cited above. Applicants contend that such a parameter is easily determined by one skilled in the art and as such it is deemed unnecessary to include such a description expressly in the application to permit duplication or solubility parameter determination. Applicants compare such a measurement to viscosity determination, which is well understood by those skilled in the art such that its manner of determination need not be detailed. Accordingly, Applicants assert that the amendment to the specification renders this objection to the specification moot and they therefore request reconsideration and withdrawal of the objection.

Claims 1-12 has been rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. First, Claims 1 and 12 have been rejected due to the term "preferably". Second, Claims 1 and 12 have been rejected for being confusing because the weight percentage of water is inconsistent with the weight percentages of the other components of the composition. Third, Claim 7 has been rejected for being confusing due to the phrase "composition further comprises further comprising". Fourth, Claim 10 has been rejected for being vague due to the term "combination". Next, Claim 11 has been rejected due to the phrases "vitamins and derivatives

P&G Case 8163

09/902,048

thereof" and "agents suitable for aesthetic purposes". Finally, the remaining claims have been rejected for depending from indefinite base claims. Applicants traverse these rejections.

Applicants respectfully submit that the claims as amended overcome the §112, second paragraph rejections posed by the Office. Claims 1 and 12 have been amended to remove the term "preferably" and modify the upper limit of the amount of water to 90%. Claim 7 has been amended to remove the superfluous phrase "further comprising". Claim 10 has been amended to recite that the claimed elastomers are a mixture of non-emulsifying and emulsifying elastomers in order that it is understood that Claim 10 is directed to a physical mixture of the two elastomer-types that results in the claimed elastomer. Claim 11 has been amended to remove the phrases "vitamins and derivatives thereof", "such", and "agents suitable for aesthetic purposes". As a result of these amendments, Applicants assert that each of the rejections under §112, second paragraph has been rendered moot. They therefore request reconsideration of the rejections as well as withdrawal of each of them.

Rejections Under 35 USC §103

Claims 1-12 have been rejected under 35 USC §103(a) as unpatentable over Schulz et al. (USP 5654362) (hereafter "Schulz") in view of Dreschler et al. (USP 607503) (hereafter "Dreschler"). The Office states that Schulz teaches silicone oils and solvents thickened by silicone elastomers, which are made by crosslinking silicone-containing precursors. The silicone oils include polydimethylsiloxane (i.e., dimethicone). The reference is also held out by the Office as teaching the inclusion of propylene glycol as well as glycol functional siloxane fluids which the Office asserts as being a "dimethicone copolyol". The Office also reasons that the reference teaches personal and facial cleansers that function as color cosmetic removers as well as compositions useful for delivery of oil and water-soluble substances like vitamins. Despite the Office's assertion of the reference's teachings, the Office notes that Schulz fails to teach methods of makeup removal that specifically include transfer resistant makeup as well as compositions that include a substrate like tissue. The Office therefore relies on Dreschler as teaching that the compositions disclosed therein may be removed by applying petrolatum or a dimethicone-based cosmetic remover to the skin or lips and rubbing the area gently with tissue. Based on this interpretation of the art, the Office asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the compositions and methods for makeup removal as taught by Schulz by removing transfer resistant makeup with the further use of a tissue in order to benefit from the removal of transfer resistant makeup as taught by Dreschler. Applicants traverse this rejection.

Applicants submit that the claimed invention is patentably nonobvious over the cited references of Schulz and Dreschler.

Schulz discloses silicone gels made by reacting $\equiv\text{Si-H}$ containing polysiloxane with an α,ω -diene. The reaction is conducted in the presence of a platinum catalyst and a low molecular weight silicone oil. First, although Schulz discloses the use of the compositions disclosed therein as personal or facial cleansers and as color cosmetic removers, the reference fails to teach or suggest the specific method claimed by Applicants that includes removing a transfer resistant makeup. Secondly, the reference fails to

P&G Case 8163

09/902,048

specify the particle size of the elastomer disclosed therein as has been done by Applicants. Applicants have found that it is particularly desirable to have elastomers made of particles ranging in size from about 10 to about 200 microns in order to deliver an aesthetically feeling makeup removing process. Furthermore, the reference fails to teach or suggest the claimed cosmetic wipe that includes a layered substrate and a composition comprising Applicants' specific elastomer, solvent, and optionally water in the requisite amounts.

Dreschler relates to cosmetic compositions for application to the lips that includes a mixture of a specific organosiloxane resin and a dimethicone gum, a volatile carrier, and a pigment wherein these ingredients are present in specific ratios. Despite Dreschler's teaching of these compositions that are transfer resistant, Applicants find no specific teaching or suggestion to use silicone elastomer containing compositions to remove such compositions. Rather, the reference teaches the use of petrolatum or dimethicone-based cosmetic removers paired with tissues for makeup removal. One skilled in the art would not necessarily have been motivated by Dreschler to arrive at the method and wipe of the present invention since there is no teaching of silicone elastomer containing compositions as required by Applicants' invention. Moreover, even if a skilled artisan had combined the respective disclosures of the cited references, he still would not have arrived at the present invention for the failed teaching of Applicants' specific elastomer having a particle size of from about 10 to about 200 microns and a water-insoluble substrate based wipe.

It is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See, SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. In re Grabiak, 222 USPQ2d 870, 872 (Fed. Cir. 1985). Furthermore, "obvious to try" is not a valid test of patentability. In re Dow Chemical Co., 5 PQ2d 1529 (CAFC 1988); In re Antonie, 195 USPQ 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. In re Cofer, 148 USPQ 268 (CCPA 1966). Thus, Applicants assert that a rejection under 35 USC §103(a) as unpatentable over the cited references is improper and therefore request withdrawal of the rejection and reconsideration.

Double Patenting

Claim 12 has been provisionally rejected for obviousness-type double patenting over Claim 12 of the commonly assigned, concurrently filed, copending application U.S. Serial No. 09/850,763.

P&G Case 8163

09/902,048

Applicants respectfully traverse the rejection because the claims of the present invention are patentably distinct from the claims of cited copending applications. To simplify the issues in the present application, however, Applicants concurrently submit with this amendment the appropriate Terminal Disclaimer over the copending applications. In submitting this Terminal Disclaimer, Applicants state for the record that this Terminal Disclaimer is not an admission of obviousness. In fact, the Federal Circuit has held that:

[T]he filing of a terminal disclaimer "simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection."

Quad Envtl. Techs. Corp. v. Union San. Dist., 20 USPQ2d 1392 (Fed. Cir. 1991).

Applicants therefore submit that the obviousness-type double patenting rejection has been overcome.

CONCLUSION

Based on the foregoing statements, Applicants respectfully submit that the Office has not made prima facie cases of obviousness and the rejections are therefore improper. Reconsideration and withdrawal of the rejections is respectfully requested. Allowance of each of the pending claims in the next Office Action is earnestly requested.

Respectfully submitted,

By 

Dara M. Kendall
Attorney for Applicants
Registration No. 43,709
Tele. No.: (513) 626-1789

September 19, 2002

Customer No. 27752

MARKED VERSION SHOWING CHANGES MADE

IN THE SPECIFICATION

Please amend the specification as follows:

Please replace the paragraph beginning at line 29 of page 8 with the following paragraph:

-- The solvent for the cross-linked siloxane elastomer comprises one or more liquid carriers suitable for topical application to human skin. These liquid carriers may be organic, silicone-containing or fluorine-containing, volatile or non-volatile, polar or non-polar, provided that the liquid carrier forms a solution or other homogenous liquid or liquid dispersion with the selected cross-linked siloxane elastomer at the selected siloxane elastomer concentration at a temperature of from about 28°C. to about 250°C., preferably from about 28°C. to about 100°C., preferably from about 28°C. to about 78°C. The solvent for the cross-linked siloxane elastomer preferably has a solubility parameter of less than about 9 (or 9)(cal/cm³)^{0.5}, more preferably from about 4 (or 4) to about 8.5 (or 8.5) (cal/cm³)^{0.5}, most preferably from about 6 (or 6) to about 8 (or 8) (cal/cm³)^{0.5}, optimally to about 6 (or 6) to about 7.5 (or 7.5) (cal/cm³)^{0.5}. Solubility parameters for the liquid carriers or other materials, and means for determining such parameters, are well known in the chemical arts. A description of solubility parameters and means for determining them are described by C. D. Vaughan, "Solubility Effects in Product, Package, Penetration and Preservation" 103 Cosmetics and Toiletries 47-69, October 1988; and C. D. Vaughan, "Using Solubility Parameters in Cosmetics Formulation", 36 J. Soc. Cosmetic Chemists 319-333, September/October, 1988. --

IN THE CLAIMS

Please amend the claims as follows:

1. A method for removing transfer resistant make-up compositions comprising the step of applying a safe and effective amount of a make-up removing composition comprising:
 - (i) from about 0.1 to about 30% of a crosslinked siloxane elastomer[, preferably] said elastomer having a particle size of from above 10 to about 200 microns;
 - (iv) from about 10 to about 80% of a solvent having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2}; and
 - (v) optionally, from about 0% to about [95] 90% water.
7. The method of Claim 1 wherein the make-up removing composition further comprises [further comprising] an emulsifier.
10. The method of Claim 1 wherein the crosslinked siloxane elastomer is a [combination] mixture of non-emulsifying and emulsifying crosslinked siloxane elastomers.

11. The method of Claim 1 wherein makeup removing compositions further comprises an active selected from the group consisting of peptides, palmitoyl-oligopeptide, farnesol, bisabolol, phytantriol, glycerol, urea, guanidine, [; vitamins and derivatives thereof such]ascorbic acid, vitamin A, vitamin E, vitamin B₃, vitamin B₅, sunscreens, anti-acne medicaments; antioxidants, flavonoids, skin soothing and healing agents, chelators, sequestrants, [agents suitable for aesthetic purposes,] opacifiers and mixtures thereof.
12. A cosmetic removing wipe, comprising:
- A. one or more layers of water-insoluble substrate; and
 - C. a safe and effective amount of a make-up removing composition comprising;
 - (iii) from about 0.1 to about 30% of a crosslinked siloxane elastomer[, preferably] said elastomer having a particle size of from above 10 to about 200 microns;
 - (iv) from about 10 to about 80% of a solvent having a solubility parameter of less than or equal to about 9 (cal./cm³)^{1/2}; and
- (iii) optionally, from about 0% to about [95] 90% water.